

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

ATTORNEYS AT LAW

1100 NEW YORK AVENUE, N.W., SUITE 600  
WASHINGTON, D.C. 20005-3934

www.skf.com

PHONE: (202) 371-2600 FACSIMILE: (202) 371-2540

RECEIVED

SEP 20 2000

TECH CENTER 1600/2900

ROBERT GREENE STERNE  
EDWARD J. KESSLER  
JORGE A. GOLDSTEIN  
SAMUEL L. FOX  
DAVID K.S. CORNWELL  
ROBERT W. ESMOND  
TRACY-GENE G. DURKIN  
MICHELE A. CIMBALA  
MICHAEL B. RAY  
ROBERT E. SOKOHL  
ERIC K. STEFFE  
MICHAEL O. LEE

STEVEN R. LUDWIG  
JOHN M. COVERT\*  
LINDA E. ALCORN  
RAZ E. FLESHNER  
ROBERT C. MILLONIG  
MICHAEL V. MESSINGER  
JUDITH U. KIM  
TIMOTHY J. SHEA, JR.  
DONALD R. MCPHAIL  
PATRICK E. GARRETT  
STEPHEN G. WHITESIDE  
JEFFREY T. HELVEY\*

HEIDI L. KRAUS  
JEFFREY R. KURIN  
RAYMOND MILLIEN  
PATRICK D. O'BRIEN  
LAWRENCE B. BUGAISKY  
CRYSTAL D. SAYLES\*  
EDWARD W. YEE  
ALBERT L. FERRO\*  
DONALD R. BANOWIT  
PETER A. JACKMAN  
MOLLY A. McCALL  
TERESA U. MEDLER

JEFFREY S. WEAVER  
KRISTIN K. VIDOVICH  
KENDRICK P. PATTERSON  
DONALD J. FEATHERSTONE  
GRANT E. REED  
VINCENT L. CAPUANO  
JOHN A. HARROUN\*  
MATTHEW M. CATLETT\*  
NATHAN K. KELLEY\*  
ALBERT J. FASULO II  
W. BRIAN EDGE\*

KAREN R. MARKOWICZ\*\*  
SUZANNE E. ZISKA\*\*  
BRIAN J. DEL BUONO\*\*  
ANDREA J. KAMAGE\*\*  
NANCY J. LEITH\*\*  
TARJA H. NAUKKARINEN\*\*

\*BAR OTHER THAN D.C.  
\*\*REGISTERED PATENT AGENTS

#7  
D.J.D  
9/22/00

September 18, 2000

WRITER'S DIRECT NUMBER:

(202) 789-5525

INTERNET ADDRESS:

BRIAND@SKF.COM

Attn: Art Unit 1636

Commissioner for Patents  
Washington, D.C. 20231

Re: U.S. Utility Patent Application  
Appl. No. 09/438,358; Filed: November 12, 1999  
For: Compositions and Methods for Recombinational Cloning of  
Nucleic Acid Molecules  
Inventors: Gerard *et al.*  
Our Ref: 0942.4640001/RWE/BJD

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement (in duplicate);
2. 62 pages of Form PTO-1449 citing 234 documents;
3. A copy of each of the 234 cited documents; and
4. One return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are

RECEIVED

Commissioner for Patents  
September 18, 2000  
Page 2

SEP 20 2000

TECH CENTER 16:02940

necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
Agent for Applicants  
Registration No. 42,473

BJD/nef  
Enclosures

P:\USERS\BRIAND\0942\4640001\091800-ids-cvr.wpd  
SKGF Rev. 4/27/00 mac

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

In re application of:

GERARD *et al.*

Appl. No. 09/438,358

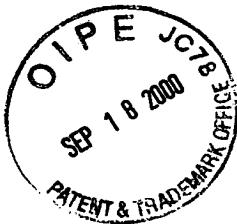
Filed: November 12, 1999

For: **Compositions And Methods For  
Recombinational Cloning of  
Nucleic Acid Molecules**

Art Unit: 1636

Examiner: Leffers, Jr., G. <sup>TECH CENTER 1600/2800</sup>

Atty. Docket: 0942.4640001/RWE/BJD



**Information Disclosure Statement**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. A copy of each of these documents is provided.

The Examiner is also referred to the following commonly owned, co-pending patent applications, which are directed to related technical subject matter:

U.S. Application No. 09/005,476, filed January 12, 1998;  
U.S. Application No. 09/177,387, filed October 23, 1998;  
U.S. Application No. 09/233,492, filed January 20, 1999;  
U.S. Application No. 09/233,493, filed January 20, 1999;  
U.S. Application No. 09/296,280, filed April 22, 1999;  
U.S. Application No. 09/296,281, filed April 22, 1999;  
U.S. Application No. 09/432,085, filed November 2, 1999;  
U.S. Application No. 09/498,074, filed February 4, 2000;  
U.S. Application No. 09/517,466, filed March 2, 2000; and  
U.S. Application No. 09/518,188, filed March 2, 2000.

The identification of these U.S. Applications is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present applications as patents. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that had been cited or submitted to the U.S. Patent and Trademark Office in a prior application relied on under

35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

This Information Disclosure Statement is being filed more than three months after the U.S. filing date but before a first Office Action on the merits. No statement or fee is required.

RECEIVED

SEP 20 2000

- 3 -

GERARD *et al.*

TECH CENTER 1600/2900 Appl. No. 09/438,358

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this pleading is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
Agent for Applicants  
Registration No. 42,473

Date: September 18, 2000

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600

P:\USERS\BRIAND\0942\4640001\IDS.wpd  
SKGF Rev. 1/26/98 clp